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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,620	10/22/2003	De-Ling Zhou	60937-0140-US	4821

9629 7590 12/16/2005

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EXAMINER
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WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/689,620

Applicant(s)

ZHOU ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/26/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-20,22-26 and 28-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-20,22-26 and 28-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The following is in response to the applicant's amendments and arguments filed 9/26/2005.

It should be noted prior to examination that the applicant's amendments are improperly marked-up. For example, new limitations were added to claim 9 without these limitations having the proper identification.

The examiner will in his best attempt try to interpret these mislabeled claims.

### ***Response to Arguments***

Applicant's arguments filed 9/26/2005 have been fully considered but they are not persuasive.

The applicant has not responded appropriately to the ODP rejections applied in the previous rejection. The applicant merely states that such rejections are overcome by the amendment but does not provide arguments to this point. As such these rejections are maintained.

The applicant has included terms such as "substantially free of hydroxylamine and of fluoride." Although the specification discusses compositions free of fluoride ions, the specification does not teach compositions free of fluoride. Noting that the fluoride ion is a specific type of fluoride compound and does not have the same scope as the term "fluoride." As such this is considered new matter (see below).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-20, 22-26, and 28-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has included terms such as "substantially free of hydroxylamine and of fluoride." Although the specification discusses compositions free of fluoride ions, the specification does not teach compositions free of fluoride. Noting that the fluoride ion is a specific type of fluoride compound and does not have the same scope as the term "fluoride." As such this when read in its broadest context such terminology is considered new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applicant's amendments have substantially altered the claim limitations. As such the following new art rejections are made.

Claim 1-4, 6-20, 22-26, and 28-41 rejected under 35 U.S.C. 102(b) as being anticipated by Lee (US5911835).

Concerning the diethylhydroxylamine, Lee teaches the following:

A cleaning solution containing 60 parts DGA, 5 parts catechol and 35 parts N,N-diethylhydroxylamine was prepared. The cleaning solution cleaned metal structures with no apparent corrosion of the structures.(see example 22)

Concerning the claimed suitable hydrazine compounds, Lee teaches the following:

The preferred nucleophilic amine compounds having reduction and oxidation potentials are alkoxy substituted amines, hydroxylamine, alkyl or carboxyl

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substituted hydroxylamine, and alkyl or carboxyl substituted hydrazine.

The most preferred compounds are hydroxylamine, N-methylhydroxylamine

hydrochloride, N,N-diethylhydroxylamine, and methylhydrazine.(see col. 8, lines 31-54)

Concerning the claimed two-carbon atom linkage alkanolamine compounds, Lee teaches the following:

Examples of suitable alkanolamines include monoethanolamine,

diethanolamine, triethanolamine, tertiarybutyldiethanolamine

isopropanolamine, 2-amino-1-propanol, 3-amino-1-propanol, isobutanolamine,

2-amino-2-ethoxypropanol, and 2-amino-2-ethoxy-ethanol, which is also

known as diglycolamine.(see col. 8, lines 55-68)

Concerning the corrosion inhibitors and the chelating agent, Lee teaches the following:

Preferred chelating agents useful in the composition of the invention are

hydroxybenzenes according to the formula:

##STR5##

wherein n=1-4, m=2-5 and R is independently hydrogen, optionally a

substituted C.sub.1 -C.sub.6 straight, branched or cyclo alkyl, alkenyl,

or alkynyl group; optionally a substituted acyl group, straight or

branched alkoxy group, amidyl group, carboxyl group, alkoxyalkyl group,

alkylamino group, alkylsulfonyl group, or sulfonic acid group; or the salt

of such compounds. The preferred compounds are the dihydroxybenzene

isomers, and the alkyl substituted dihydroxybenzenes. The most preferred

compounds are 1,2-dihydroxybenzene and 1,2-dihydroxy-4-t-butylbenzene.(see col. 9, lines 11-30)

### ***Double Patenting***

Previous ODP type rejections are maintained. As the applicant has not provided arguments concerning these reference nor has the applicant filed terminal disclaimers such rejections are maintained.

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'G. Webb', with a large, stylized initial 'G' and a long, sweeping horizontal stroke extending to the right.

Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gew